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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,232	08/28/1998	DAVID A. MONROE	067839.00700	3262

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Robert C Curfiss  
Jackson Walker LLP  
112 E Pecan Suite 2100  
San Antonio, TX 78205

EXAMINER

CHIEU, PO LIN

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 01/29/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/143,232	MONROE ET AL.
	Examiner Polin Chieu	Art Unit 2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 November 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7,9-15 and 21-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-7,9-15,21-25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) All b) Some \* c) None of:

        1. Certified copies of the priority documents have been received.

        2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .      6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 11/7/03 have been fully considered but they are not persuasive. The declaration provide on 3/3/03 (paper no. 16) is considered to be improper (discussed below). Additionally, the Applicant has argued that Nagasaka et al and Krause et al do not disclose that a still picture can be selected on the fly from a video as the video is captured, wherein the still can be transmitted to a remote receiver while the recorder continues to record or while video is being simultaneously transmitted to another remote receiver. Firstly, only claim 21 may be recites a limitation that includes simultaneous transmission. Additionally, claim 21 recites simultaneously distributing to a recorder/player, a processor, and a monitor; and the examiner questions whether the processor can be considered to be another remote receiver since it appears to be internally located in the device. Kozuki et al discloses selecting video on the fly as the video is capture; however, it is not clearly shown that Kozuki et al can simultaneously record and transmit the still picture (fig. 7 shows data being set to the transmitting portion 307-311 and the recording circuit 306, but it cannot be determined in the data is sent simultaneously). Krause et al teaches a means of simultaneously recording and reproducing data, wherein the data can be transmitted to a video monitor or the like (col. 10, lines 41-52). Neither Nagasaka et al nor Krause et al solely discloses the limitations of claim 21; however, the combination of Kozuki et al, Nagasaka et al, and Krause et al is considered to disclose the limitations of the claim.

2. The declaration filed on 3/3/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Fujita et al reference.
3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Fujita et al reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Conception requires every limitation recited to be shown (MPEP 2138.04). Even if the examiner assumes that components shown in the figure provided with the declaration correspond to the components shown in figure 2 of the Applicants invention, the figure does not anticipate all the limitations recited. For example, claim 1 recites that a full motion video signal may be distributed to the recorder/player while a selected still frame is distributed to other components of the system; and claim 21 further recites that the video signal is simultaneously distributed to the recorder/reproducer, processor, and display monitor. The examiner can not determine using the figure provided with the declaration that the above described operations are performed i.e. viewing the figure does not allow a person of ordinary skill in the art to determine that video signal is simultaneously distributed to the recorder/reproducer, processor, and display monitor.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-6, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al (6,069,994) in view of Nagasaka et al (6,195,497).

Regarding claim 1, Kozuki et al discloses a recorder/player (306), a video signal source for providing a video source (301), and a video signal transmission system (307-311) in figure 7. Kozuki et al also discloses a video signal switching system (305) responsive for selectively distributing the video signal to the recorder/player (306), the display monitor (not shown), and the transmission system (307-311), wherein a full motion video signal may be distributed to the recorder/player (306) while a selected still frame of the video signal is distributed to other components (313) of the system (col. 2, lines 14-19). Kozuki et al does not disclose a video signal display monitor or a central processing unit (CPU) for controlling the recording/playback system.

Kozuki et al teaches a CPU (115) controlling a recording/reproducing device in figure 10 and a display (143) in figure 15. Many electronic devices, such as VCRs, use CPUs to control recording and playback. A display would have to be connected to the output of the embodiment (311) shown in figure 7 to view to video signal.

Nagasaka et al teaches a system adapted to select said frames by searching for the marks in figure 1, for distribution of the recorded marked frames. The

“representative frames” in the table (1108) use the marks (1002-1006, fig. 13) to search the frames. Since “representative frames” from a scene exist, marking must have occurred at some point (whether marked by the CPU or a user); therefore, a marking signal generator, whereby specific, selected still frames of recorded full motion video signal may be marked (1002) must have been present in the device.

It would have been highly desirable to have a video signal display monitor so that the images could be viewed. It would have been highly desirable to have a CPU to generate control signals that control the functions of the device. It would have been highly desirable to have a marking signal generator so that a portion of full motion video can be quickly identified and distributed for editing purposes.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a video signal display monitor and a marking signal generator in Kozuki et al.

Regarding claim 2, Kozuki et al discloses a digital capture system for creating a still frame on the fly as the full motion video signal is generated by the video signal source (col. 1, line 65 to col. 2, line 13). Kozuki et al also discloses recording a full field still frame (col. 2, line 9).

Regarding claim 3, Kozuki et al discloses a means for capturing a selected group of sequential still frames on the fly as the full motion video signal is generated by the video signal source (col. 3, lines 10-20).

Regarding claim 5, Kozuki et al discloses an audio signal generator for generating an audio signal (col. 1, lines 1-65). It is well known in the art that an audio

signal can be recorded by the recorder/player in real time synchronization with the full motion video signal. Further synchronizing audio and video is common practice in VTRs.

In claim 6 the data signal can be interpreted as an audio signal. Please refer to the art rejection of claim 5.

Regarding claim 9, Kozuki et al does not disclose a marking signal generator with two modes.

Nagasaka et al teaches using a frame to represent the contents of a scene or a "representative frame". The examiner takes Official Notice that two methods of selecting "representative frames" are well known in the art. The first method is a manual method in which a user selects a particular frame from a scene as the representative image for the scene. The second method is activated by a preselected data signal wherein the preselected data signal is a predetermined interval.

It would have been highly desirable to have two modes so that the user could select marking points or the device would automatically select marking points.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have two modes for the marking signal generator in Kozuki et al.

The limitations of claim 11 are similar to claim 1 without the display monitor. Claim 11 additionally recites an audio signal source. Kozuki et al does not disclose audio signal source in the embodiment shown in figure 7.

Kozuki et al teaches recording an audio signal (col. 1, lines 36-64). Clearly the audio signal must have a source such as a microphone.

It would have been highly desirable to have an audio signal source for recording so that the device can record audio with the video.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an audio signal source in the device of Kozuki et al.

6. Claims 4 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Nagasaka et al and Krause et al (6,304,714).

Regarding claim 4, Kozuki et al discloses a first mode for transmitting full motion video (discussed in claim 1) and second mode for transmitting full motion video signals as a playback of the recorded full motion video signal from the recorder/player (col. 7, line 39 to col. 8, line 4). However, Kozuki et al does not disclose transmitting full motion video in a first mode as the full motion video is generated by the video signal source.

Krause et al teaches simultaneous recording and reproduction (col. 10, lines 41-52). This would allow Kozuki et al to receive (and record) a video signal while a signal is being transmitted to an output device (display).

It would have been highly desirable to transmit a signal while receiving a signal so that a user could watch any portion of the recorded video while the signal is recording (unlike conventional VCRs).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit a signal while receiving the signal in the device of Kozuki et al.

Regarding claim 21, a-f were previously discussed in the art rejection of claim 1. Please refer to the art rejection of claim 1. Kozuki et al discloses a video switching system with a first switching means for switching between a first and second position (305, fig. 7), wherein the first switching means distributes the video signal to the recorder/player (306), the processing unit (304), and the display monitor (311, refer to art rejection of claim 1); and a memory storing still frames (312). However, Kozuki et al does not disclose that the switching means performs simultaneous distribution such that a full motion video signal may be recorded by the recorder/player while one or more selected still frames of the video signal are generated to produce one or more full field still frames so that the still frames can be retrieved without interruption of the recording function.

Krause et al teaches simultaneous recording and reproduction (col. 10, lines 41-52). Simultaneous recording and reproduction allows the device to send the video signal to the recorder/player (recording); the display monitor (reproduction); and the processing unit (recording and/or reproduction) while one or more selected still frames are generated to produce full field images without interruption of the recording process.

It would have been highly desirable to have the simultaneous recording and reproduction features of Krause et al so that a viewer can view a video signal from the tape while recording to the tape (col. 10, lines 41-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have the simultaneous recording and reproduction features in the device of Kozuki et al.

Regarding claim 22, Kozuki et al discloses that the second position of the switching means allows playback of the recorded full motion video signal from the recorder/player or display of the full field still frames from the memory on the display monitor (fig. 7; 313, 305, 307-311).

Regarding claim 23, Kozuki et al does not disclose a remote control unit.

The examiner takes Official Notice that a remote control unit coupled to a processing unit for manual control of a system is well known in the art (i.e. VCR remote).

It would have been highly desirable to have a remote control unit so that the user can control the device from distances away from the device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a remote control unit in the device of Kozuki et al.

7. Claims 7 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Nagasaka et al and Cooper (5,508,736).

Regarding claim 7, Kozuki et al does not disclose a GPS signal generator.

Cooper discloses a GPS signal generator (col. 4, lines 1-32).

It would have been highly desirable to have GPS signal generator so that a person or vehicle's position can be located from the signal.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a GPS signal generator in Kozuki et al.

Regarding claim 13-15, Kozuki et al does not disclose a data signal source for recording comprising a GPS receiver and an encryption unit for encrypting a signal.

Cooper teaches a data signal source comprising position data (col. 4, lines 5-49) and an encryption unit 13 in figure 1.

Cooper teaches that it would have been highly desirable to have a data signal source so that comments can be recorded with navigational data (col. 4, lines 33-49). It would have been highly desirable to encrypt the data so that only people with the proper codes to decrypt the data would be able to view it.

Therefore, it would have been highly desirable to a person of ordinary skill in the art at the time of the invention to have a data signal source comprising a GPS receiver and an encryption unit in the device of Kozuki et al.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Nagasaka et al and Freeman (5,684,716).

Kozuki et al does not disclose that the central processing unit is a Pentium class processor.

Freeman discloses a video transmission device using a PC (col. 2, lines 60-65). It is well known in the art that PCs often use Pentium class processors. It would have been highly desirable to have a PC, which could have a Pentium class processor, so that a video signal can be transmitted to a host unit by cellular phone (col. 4, lines 10-30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a Pentium class processor in Kozuki et al.

9. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Nagasaka et al and Nitardy (5,396,651).

Kozuki et al does not disclose that the audio signal source comprises an aircraft interphone.

Nitardy teaches the use of an aircraft interphone (col. 3, lines 5-35).

It would have been highly desirable to have the audio signal source comprise an aircraft interphone so that the communications between the aircraft and another aircraft can be recorded. In a plane crash, these recordings may allow investigators to determine the cause of the crash.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an aircraft interphone in the device of Kozuki et al.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Nagasaka et al, Krause et al, and Cooper.

Kozuki et al does not disclose a data signal generator for generating one or more data signals for recording by the recorder/player, displaying on the display monitor, or transmission to the transmission system in real time synchronization with the full motion video signal.

Cooper teaches combining GPS and/or other data with the video signal (col. 3, line 55 – col. 4, line 49). The data would obviously be in real time synchronization with the full motion video since the data represents GPS information at a particular time that the video signal was recorded. Additionally, since the GPS and/or other data is combined with the video signal, and the video signal is supplied to the recorder/player, the display, and the transmission system, it can be assumed that the GPS and/or other data is sent to the recorder/player, the display, or the transmission system.

It would have been highly desirable to have GPS and/or other data so that vehicle heading, altitude, speed, and/or user comments can be combined with the video (col. 3, line 55 – col. 4, line 49).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have GPS and/or other data in the device of Kozuki et al.

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Nagasaka et al, Krause et al, and Sugawara et al (5,471,316).

Kozuki et al does not disclose a second switching means for switching between a plurality of video signal sources.

Sugawara et al teaches a switching means for switching between a plurality of video signal sources (10, fig. 1).

It would have been highly desirable to have a second switching means so that a user can select from several difference video sources for recording.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a second switching means in the device of Kozuki et al.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-Th 8:00 AM-6:30 PM.

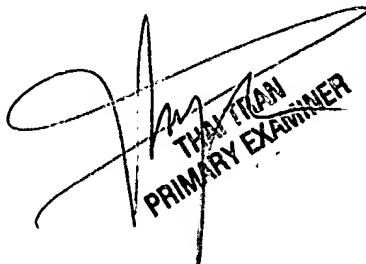
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



THAT TRAIL  
PRIMARY EXAMINER

A handwritten signature of Polin Chieu is written over a printed name. The printed name "THAT TRAIL" is at the top, followed by "PRIMARY EXAMINER" in a larger, slanted font.